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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,608	02/06/2004	Michael G. Fisher	021976-000200US	7771
20350 7590 10/16/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER HOFFMAN, MARY C	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 10/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/773,608

Applicant(s)

FISHER ET AL.

Examiner

Mary Hoffman

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-53, 55-80 and 115-121 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-53, 55-80 and 115-121 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/6/04, 4/12/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 116 is objected to because of the following informalities: In claim 116, line 3, "at last one" should be changed to --at least one--.

Also, it is noted that there exists an inconsistency between the language of claim 1 and that of the claims 30-38 dependent thereon, thus making the scope of the claim unclear. In claim 1, applicant recites "A device...comprising at least one stationary femoral member..., and at least one adjustable femoral member" with the tibial member being only functionally recited, i.e. "to contact a tibial member...movably engageable with at least one tibial member...", thus indicating that the claim is directed to the subcombination, "A device...comprising at least one stationary femoral member..., and at least one adjustable femoral member". However, in claims 30-38, applicant positively recites the tibial member as part of the invention, i.e. "wherein the at least one tibial member is engageable.", thus indicating that the combination, a device...comprising at least one stationary femoral member...and at least one adjustable femoral member, and tibial member, is being claimed. As such, it is unclear whether applicant intends to claim the subcombination or combination. Applicant is hereby required to indicate to which, combination or subcombination, the claims are intended to be directed, and amend the claim such that the language thereof is consistent with this intent. For examination purposes claims 1-41 will be considered as being drawn to the subcombination, a

Art Unit: 3733

device...comprising at least one stationary femoral member..., and at least one adjustable femoral member.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13, 15-53, 55-80 and 115-121 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's amendments "disposed at a right angle" in claim 1, line 7 and claim 42, line 8, is being considered new matter. The drawings do not show "a right angle" rather, the drawings illustrate an approximate right angle. Since the posterior condylar member of claims 1 and 42 is disposed substantially at a right angle and not indicated as an exact right angle (i.e. 90 degrees), applicant should amend the claims accordingly by adding terminology such as "substantially", "approximate", or the like, to the phrase "disposed at a right angle."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 7, 30-37, 39-41, 115-116 and 118-119 are rejected under 35 U.S.C. 102(b) as being anticipated by Petersen (U.S. Patent No. 4,567,886). Petersen discloses a stationary femoral member (ref. #14,16), an adjustable femoral member (ref. #24,26,34) with a posterior condylar portion extending at a right angle, or perpendicularly, with an adjustment member (ref. #42,44 or ref. #18,32) that moves the adjustable femoral member in an anterior-posterior direction to the stationary femoral member. With regard to the statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Petersen, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). It is noted that the

Art Unit: 3733

tibial member is not positively recited in claim 1 or its dependent claims. The tibial member (see ref. #54,55) is engageable with the tibial surface and comprises a rod and platform. The femoral members are capable of being coupled together by force provided by the knee's ligaments. The femoral members are disposed primarily within the joint space. The device includes a grasping member (top of ref. #34). The stationary femoral member comprises a plate and a perpendicular stationary condylar member.

Claims 1-4, 7, 16, 30-37, 39-45, 47, 56, 70-77, 79, 80, 115-117, 119 and 121 are rejected under 35 U.S.C. 102(b) as being anticipated by Luckman (U.S. Patent 5,520,695).

Luckman discloses a stationary femoral member (ref. #23, FIG. 6), an adjustable femoral member (ref. #19, FIG. 6) with a posterior condylar portion extending at an approximate right angle, or perpendicularly, with an adjustment member (see slot ref. #20) that moves the adjustable femoral member in an anterior-posterior direction to the stationary femoral member. With regard to the statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Luckman, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art

Art Unit: 3733

apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). It is noted that the tibial member is not positively recited in claim 1 or dependent claims. The tibial member (ref. #16) is engageable with the tibial surface and comprises a rod and platform, and has a complementary depression (ref. #22). The femoral members are capable of being coupled together by force provided by the knee's ligaments. The femoral members are disposed primarily within the joint space. The device includes a grasping member (top of ref. #17).

Claims 1-2, 7, 30-37, 39-41 and 118-119 are rejected under 35 U.S.C. 102(b) as being anticipated by Haines et al. (U.S. Patent No. 5,597,379).

Haines et al. disclose a stationary femoral member (see FIG. 2, ref. #20), an adjustable femoral member (ref. #62, 70) with a posterior condylar portion extending at an approximate right angle, or perpendicularly, with an adjustment member (ref. #70) that moves the adjustable femoral member in an anterior-posterior direction to the stationary femoral member. With regard to the statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Haines et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art

Art Unit: 3733

apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). It is noted that the tibial member is not positively recited in claim 1 or dependent claims. The device includes a grasping member (ref. #64).

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

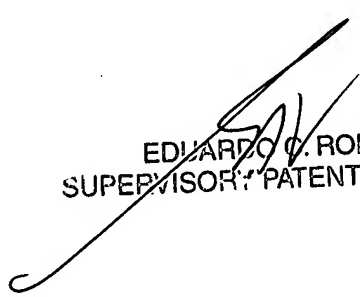
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH


EDUARDO C. ROBERT
SUPERVISOR, PATENT EXAMINER